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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,291	09/11/2003	Robert Markes	1339BGN-US	5615

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Dekel Patent Ltd.
Beit HaRofim
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Rehovot,
ISRAEL

EXAMINER

ALEXANDER, LYLE

ART UNIT	PAPER NUMBER
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1797

MAIL DATE	DELIVERY MODE
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02/11/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/659,291	Applicant(s) MARKES, ROBERT	
	Examiner Lyle A. Alexander	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-10 and 12-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5-10 and 12-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 5-10 and 12-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shain et al. (USP 6,027,349), Douglas et al. (USP 5,951,492), Moerman et al. (USP 6,706,159) or Stiene et al. (2004/0096959) in view of Eason et al (USP 5,186,897) alone or further in view of Tenerz et al. (USP 4,941,473).

See the appropriate paragraph of the 3/4/08 Office action.

With respect to new claims 16-19, Shain et al. (USP 6,027,349), Douglas et al. (USP 5,951,492), Moerman et al. (USP 6,706,159) and Stiene et al. (2004/0096959) all teach optical/colorimetric reactions that include a light source to facilitate analysis. These references are silent to the use of the claimed "coherent light" or "non-coherent light.

The court decided In re Boesch (205 USPQ 215) that optimization of a result effective variable is ordinarily within the skill of the art. A result effective variable is one that has well known and predictable results. The selection of the type of light best suited to resolve the particular analyte/reagent combination is a result effective variable. The selection of either coherent or non-coherent light is a result effective variable having the well known and expected results of providing the optimal conditions to best resolve the particular analyte/reagent combination.

It would have been within the skill of the art to modify Shain et al. (USP 6,027,349), Douglas et al. (USP 5,951,492), Moerman et al. (USP 6,706,159) or Stiene et al. (2004/0096959) and use either coherent or non-coherent light as optimization of a result effective variable and to gain the above advantages.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shain et al. (USP 6,027,349), Douglas et al. (USP 5,951,492), Moerman et al. (USP 6,706,159) or Stiene et al. (2004/0096959) in view of Eason et al (USP 5,186,897) alone or further in view of Tenerz et al. (USP 4,941,473) as applied to claims 1, 5-10 and 12-19 above, and further in view of Stanton et al (US 2004/0219523).

Shain et al. (USP 6,027,349), Douglas et al. (USP 5,951,492), Moerman et al. (USP 6,706,159) or Stiene et al. (2004/0096959) in view of Eason et al (USP 5,186,897) alone or further in view of Tenerz et al. (USP 4,941,473) are silent to the use of a "surface Plasmon resonance sensor."

Stanton et al. teach in paragraph [0255] a "surface Plasmon resonance sensor" (referenced hereafter as "SPR") in combination with a waveguide to gain the advantages of real time analysis of biological sample. Paragraph[0767] teach the SPR provides very sensitive analysis of binding/unbinding of analytes.

It would have been within the skill of the art to use a known technique to improve a similar device in the same way. Stanton et al. teaches SPR is known and used in combination with a waveguide for analysis of analytes in biological fluids. Stanton et al. also teach the SPR is advantageous because it provides sensitive, real time analysis of the analytes.

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It would have been within the skill of the art to further modify Shain et al. (USP 6,027,349), Douglas et al. (USP 5,951,492), Moerman et al. (USP 6,706,159) or Stiene et al. (2004/0096959) in view of Eason et al (USP 5,186,897) alone or further in view of Tenerz et al. (USP 4,941,473) as applied to claims 1 and 5-19 above, and further in view of Stanton et al (US 2004/0219523) and use a SPR sensor to gain the above advantages.

Response to Arguments

Applicant's arguments filed 6/4/08 have been fully considered but they are not persuasive.

Applicant's state the combination of Easton et al. with the cited prior art does not meet the limitations of the instant invention.

Appellant states Shain et al. fail to teach the claimed "disposable housing." These remarks are only commensurate in scope with pending claims 5 and 15. With respect to claims 5 and 15, the language "disposable" is sufficiently broad to have been read on the cited prior art because the prior art devices are eventually disposed of. Additionally, the claimed "disposable" is directed to a method of intended use which is of no patentable moment with respect to the pending apparatus claims as long as the apparatus has the capability to be used in the same manner (e.g. the prior art device can be dispose of).

These remarks are not convincing because Easton et al. has been used to teach the desirability of optical waveguides. One cannot show nonobviousness

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by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

This is a RCE of applicant's earlier Application No. 10/659,291. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A. Alexander whose telephone number is

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571-272-1254. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lyle A Alexander/
Primary Examiner, Art Unit 1797

Lyle A Alexander
Primary Examiner
Art Unit 1743